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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/258,609	02/26/1999	HIROSHI KOBATA	EPC-009	4096
26171	7590	05/06/2003		
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			EXAMINER KANG, PAUL H	
			ART UNIT 2142	PAPER NUMBER
			DATE MAILED: 05/06/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/258,609	KOBATA ET AL.	
	Examiner	Art Unit	
	Paul H Kang	2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06 February 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 February 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5-11, 13, 16-17, 19, 23, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo, II, US Pat. No. 5,675,507 in view of Kumar et al., US Pat. No. 6,240,445 B1.

2. As to claims 1, 13 and 16, Bobo discloses an apparatus for delivering a document to a receiving station over a network, comprising:

a server system connected to the network and storing digital information received over the network (Bobo, abstract, col. 4, lines 54-67); and

the apparatus connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system (Bobo, abstract, col. 4, line 23 – col. 5, line 40).

However, Bobo does not explicitly teach that the sending system transmits both the digital information and a notification to the receiving system. In the same field of endeavor,

Kumar teaches a system for transmitting from a sending machine a notification to the recipient as well as the digital information to a storage server (Kumar, col. 7, line 20 – col. 9, line 4; computer 18 (the sending system) transmits a copy of a facsimile to a remote storage archive (see Kumar, col. 8, lines 60-66) as well as transmitting to the recipient a notification of the facsimile document). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of transmitting both a notification and digital information into the system of Bobo for the purpose of enhancing load balancing of storage archives as well as enhancing data routing efficiency.

3. As to claims 2 and 23, Bobo-Kumar teaches the server system receives the digital information from the sending system (abstract, col. 4, lines 54-67).

4. As to claims 5-7, Bobo-Kumar teaches a storage device in communication with the server and wherein the server system stores the digital information at an address location of the storage device, and wherein the server system includes a page providing a path by which the receiving system can access the digital information at the address location, wherein the notification has a resource locator which addresses the page on the server system (Bobo, abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 8, line 40).

5. As to claims 8 and 27, Bobo-Kumar teaches the page requests valid authentication information from the receiving system before granting access to the digital information (Bobo,

fig. 3 and col. 7, lines 25-37).

6. As to claims 9-11, Bobo-Kumar teaches a page which provides access to a graphical window describing contents of the digital information and resource locators reference multiple locations in the storage device to access the data structure using the unique identifiers (Bobo, abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 7, line 50).

7. As to claims 17 and 19, Bobo-Kumar teaches transmitting the digital information from the server system to the receiving system in response to a request from the receiving system and executing a server-side software through which the receiving system can obtain access to the digital information (Bobo, abstract, col. 7, lines 39-67).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4, 12, 14-15, 18, 20-22, 24-26, and 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobo-Kumar, as applied above, in view of Masters, US Pat. No. 5,872,930.

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10. As to claim 3-4 , 12, 14-15 and 24-26, Bobo-Kumar teaches the invention substantially as claimed. Bobo-Kumar teaches a message delivery system comprising multiple computers, including senders, receivers and server, communicating over the internet (Bobo, col. 6, lines 20-56). However, Bobo-Kumar does not explicitly teach a second server system in communication with the sending system and the first server system, wherein the first server system receives the digital information from the sending system via the second server system, acting logically as a single server system.

Masters teaches a email server system used to route a message through multiple servers based on server load (Masters, col. 2, line 18 – col. 4, line 35 and fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a second server into the system, as taught by Masters, into the system of Bobo-Kumar for the purpose of increasing data transmission efficiency by distributing tasks among multiple servers.

11. As to claims 18 and 28-29, Bobo-Kumar-Masters teaches the invention substantially as claimed. However, Bobo-Kumar-Masters does not explicitly teach the step of tracking the digital information in real-time, confirming that the receiving system has completely received the digital information and notifying the sending system when the receiving system starts using the digital information.

Official notice is taken (see MPEP 2144.03) that tracking message transmission was well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a method of

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confirming that a message was completely received into the system of Bobo-Kumar-Masters for the purpose of increasing data transmission reliability.

12. As to claims 20 and 21, Bobo-Kumar-Masters teach the step of maintaining a page on the server system through which the receiving system can obtain access to the digital information and the notification includes the resource locator for accessing the page (Bobo, abstract, col. 4, lines 54-67 and col. 6, line 66 – col. 8, line 40).

13. As to claim 22, Bobo-Kumar-Masters teaches the step of concurrently sending a notification and digital information (Kumar, col. 7, line 20 – col. 9, line 4).

14. As to claims 30 and 31, Bobo-Kumar-Masters teaches the invention substantially as claimed. However Bobo-Kumar-Masters does not explicitly teach the step of canceling delivery after sending the digital information.

Official notice is taken (see MPEP 2144.03) that canceling a message was as well known in the computer networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated a step to cancel a message anytime after it has been sent into the system of Bobo-Kumar-Masters for the purpose of enhancing the control of the data transmission.

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15. As to claim 32, Bobo-Kumar-Masters teaches the invention substantially as claimed.

However Bobo-Kumar-Masters does not explicitly teach the step of restarting a connection after an interruption at the point of interruption.

Official notice is taken (see MPEP 2144.03) that restarting a connection at the point of interruption was well known in the networking art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated method to restart a connection at the point of interruption into the system of Bobo-Kumar-Masters for the purpose of increasing system fault tolerance.

16. Claims 1, 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., US Pat. No. 5,790,790 in view of Ishibashi et al., EP 0 812 100 A2.

17. As to claims 1, 13 and 16, Smith discloses an apparatus for delivering a document to a receiving station over a network, comprising (See Smith, col. 2, lines 20-31):

a server system connected to the network and storing digital information received over the network (See Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10); and

the apparatus connected to the network and transmitting a notification to the receiving system, the notification signifying that the sending system is transmitting the digital information over the network to the server system and that the digital information may be accessible by the receiving system at the server system (Smith, col. 2, lines 20-31 and col. 6, line 40 – col. 7, line 10).

However, Smith does not explicitly teach that the sending system transmits both the digital information and a notification to the receiving system. In the same field of endeavor, Ishibashi teaches a system for transmitting from a sending machine a notification to the recipient as well as the digital information to a storage server (See Ishibashi, Abstract and page 2, lines 40-59 and page 6, lines 6-27 and page 6, line 27 – page 7, line 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the method of transmitting both a notification and digital information as taught by Ishibashi into the system of Smith for the purpose of providing an efficient and immediate notification and message transmission system.

18. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection. The Applicants argued in substance that the prior art of record failed to teach the sending system transmitting a notification to the recipient as well as the digital information. The new grounds of rejection teaches this feature.

Response to Arguments

Applicant's arguments with respect to claims 1-32, filed February 6, 2003 (paper no. 20), have been fully considered but they are not persuasive. The Applicant argued in substance that:

A) "...[N]either Bobo, Kumar nor any combination of the two describes or suggests having a sending system transmit a notification to a receiving system, with the notification signifying that the sending system is transmitting digital information over a network to a server.

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system, and that the digital information may be accessible by the receiving system at the server system, as recited in claim 1...Computer 18 is the portion of the system which notifies the user and receives/stores the facsimile message (i.e. digital information) that may be retrieved later by the user. In contrast, the apparatus recited in claim 1 includes a sending system that transmits a notification to a receiving system, with the notification signifying that the sending system is transmitting the digital information over the network to the server system, and that the digital information may be accessible by the receiving system at the server system..."

As to point A, Applicant argues limitations which are not essential to the scope of the prior art. The definiteness of the language employed must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Insofar, the claims have been given the broadest reasonable interpretation consistent with the specification and the prior art during the examination of this patent application since the applicant may then amend his claims, the thought being to reduce the possibility that after a patent is granted, the claims may be interpreted as giving broader coverage than is justified.

In this case, the sending system is not limited by the claim language to be the sender in Kumar. The sender may also be the server system of Kumar, and the server system may be the storage device of Kumar. Therefore, the computer 18 transmits the notification to the user of the storage of a message awaiting the user at a storage device – this message includes the memory location in the storage device where the message is stored.

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B) "Nor does Kumar disclose that computer 18 transmits a notification that the sending system is transmitting the digital information over the network to the server system." Reply, page 3. Applicant's interpretation of the invention as claimed can also be seen in Applicant's arguments to Smith, regarding the same claim limitation. "Since the communication device sends the notification facsimile after transmitting the digital information (i.e. the electronic mail message), the notification message necessarily would not signify that the sending system is transmitting digital information that may be accessible at the server system. Rather, the message would, at least, indicate that the sending system transmitted digital information that may be accessible at the server system." Reply, pages 5 and 6.

As to point B, Applicant argues limitations which are not essential to the scope of the prior art. See point A above. Therefore, applicant's arguments regarding "transmitting" are not given weight as to the patentability of the claimed subject matter. The step of sending a notification that the sender is "transmitting" the message to the server, incorporates the entire process of the notification of the message.

C) "In particular, Kumar's storage of the digital information at the sending computer system, even if separate from the compute system itself, does not constitute transmitting digital information over a network from a sending system to a server system, from which the digital information is accessed by a receiving system since, in Kumar's system, the recipients later access messages through the computer 18. See [Kumar] at col. 5, lines 31-36 and lines 59-65."

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As to point C, the transfer of the message to a storage device constitutes a network data transfer. This system is a network based system. Further, the storage device is not explicitly required to be internal to computer 18, but may be remote to computer 18. See Kumar, col. 5, lines 31-36, as well as lines 36-38, for example.

D) The arguments as to Masters relies solely on Applicant's arguments based on Bobo-Kumar, therefore, the above responses to Applicant's arguments are incorporated in its entirety.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Paul H Kang
Examiner
Art Unit 2142

May 5, 2003

